REMARKS

Claims 5-11, 16, 17 and 19-40 are pending in this application. By this Amendment, Applicants amend Claim 5, 16, 17, 19-21 and 23 and cancel claims 1-4 and 12-15.

Claims 1-17 and 19-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida (JP 56-119280) in view of Mori et al. (U.S. 5,644,339). Applicants respectfully traverse this rejection.

Claim 5 has been amended to recite:

> "An image processing device comprising:
> **image processing means for executing image processing to move an object to different positions on a display means**;
> display means for displaying an image at an object display position based on the image processing;
> contact means movably provided and brought into contact with said display means by the operation of a player;
> **input means provided on a side of said display means and generating at least one signal for computing a contact position when said contact means is brought into contact with said display means, such that the strength of the at least one signal depends on the contact position**;
> position computing means for computing said contact position based on the at least one signal from the input means; and
> determination means for determining whether a desired positional relationship is established between said contact position and said object display position based on a computed result;
> wherein said image processing means provides prescribed image processing of said object when the determination means determines that the desired positional relationship has been established." (Emphasis added)

Claims 16, 17, 19, 20, 21 and 23 recite features or method steps that are similar to the features recited in claim 5, including the emphasized features.

The Examiner alleged that Yoshida teaches an image processing device including "image processing means for executing image processing to move an object to different positions on a display means." The Examiner acknowledged that Yoshida fails to teach or suggest position computing means. However, the Examiner further

alleged that Mori et al. teaches position computing means for computing said contact position, contact input means movable and brought into contact with a display means and determination means for determining whether a desired positional relationship is established. Thus, the Examiner concluded that it would have been obvious "to utilize the apparatus of Yoshida and implement the teaching of Mori et al., as to contact input means and other aforementioned means. . . because it would result in fast response and accurate results in a game environment." Applicants strongly disagree.

Yoshida teaches a "whacking game" including a plurality of display panels 2 and light sources 4, 4' for displaying target images on the display panels and a hammer 5 which includes photo sensors 11, 11'. The display panels 2 are nothing more than pieces of glass or plastic which have static images provided thereon, such that when the light sources 4, 4' are turned on, the static image provided on the display panel lights up. When the display panel lights up, the player uses the hammer to "whack" the image, and the photo sensors in the hammer generate a signal indicating that the target image was hit. In the "whacking game" of Yoshida, there is absolutely no movement of an object to different positions on a display means.

Therefore, contrary to the Examiner's allegation that Yoshida teaches image processing means for executing image processing to move an object to different positions on a display means, Yoshida clearly fails to teach or suggest "an image processing means for executing image processing to move an object to different positions on a display means" as recited in the present claimed invention.

In fact, Yoshida teaches away from the claimed invention because there is absolutely no movement of the objects/images of Yoshida because the images of Yoshida are static images which are merely lit by the light source 4, 4'. Thus, Yoshida clearly fails to teach or suggest image processing means for executing image processing to move an object to different positions on a display means. Accordingly, Yoshida cannot be relied upon in an obviousness rejection of Applicants' claimed invention since it is error to find obviousness where references diverge and teach away from the invention at hand. W.L. Gore & Assoc. v. Garlock Inc., 721 F .2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

Further, assuming *arguendo* that Yoshida teaches the image processing means as the Examiner alleged, since there is absolutely no movement of the images in Yoshida, there clearly would have been no motivation to combine the teachings of the electronic information apparatus of Mori et al. with the "whacking game" of Yoshida. The Examiner contends that it would have been obvious to combine the teachings of Mori et al. with Yoshida because "it would result in fast response and accurate results in a game environment." However, due to the very simple design of Yoshida including the static images which do not move to different positions on a display means, there would have been absolutely no reason to determine the contact coordinates in Yoshida, and thus no reason to combine features of Mori with the device of Yoshida. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

In addition, as acknowledged by the Examiner, Mori et al. teaches a contact input means movable and brought into contact with a display means. The only contact input means disclosed in Mori et al. is a stylus pen 11 which is used to contact a digitizer 10 on an LCD 17. The stylus is a completely separate element from the display means and is used to receive various information provided on the LCD 17, and is completely incapable of generating or computing the strength of a signal based on the contact position. Thus, Mori et al. clearly fails to teach or suggest any input means provided on a side of a display means, and certainly fails to teach or suggest "input means **provided**

on a side of said display means and generating at least one signal for computing a contact position when said contact means is brought into contact with said display means, such that **the strength of the at least one signal depends on the contact position**" as recited in the present claimed invention.

Accordingly, Applicants respectfully submit that Yoshida and Mori et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements and method steps recited in the present claimed invention.

Applicants respectfully submit that the Examiner has continually engaged in piecemeal prosecution of the present application. Particularly, in the Office Action dated March 26, 2002, the Examiner rejected the claims under **only** 35 U.S.C. § 112, second paragraph, and made **NO** prior art rejections. In response, Applicants amended the claims to correct the informalities noted by the Examiner, and submitted that the application was thus in condition for allowance. However, in the Office Action dated October 2, 2002, the Examiner withdrew the rejection under 35 U.S.C. § 112, second paragraph, and, instead of allowing the application, the Examiner has issued another prior art rejection which clearly could have been made in the Office Action dated March 26, 2002.

Piecemeal prosecution is explicitly discouraged in MPEP 707.07(g) which states that "piecemeal prosecution should be avoided as much as possible. The Examiner ordinarily should reject each claim on all valid grounds available..." In this application, the Examiner has clearly failed to reject each claim on all grounds. Accordingly, Applicants respectfully request that the Examiner refrain from continuing piecemeal prosecution to expedite prosecution of the present application.

In view of the foregoing Amendments to the Claims and Remarks, Applicants respectfully submit that Claim 5, 16, 17, 19-21 and 23, are allowable over the prior art for the reasons described above. Claims 6-11, 18, 22 and 24-40 are dependent upon claims 5, 16, 17, 19-21 and 23, and are therefore allowable for at least the reasons that claims 5, 16, 17, 19-21 and 23 are allowable.

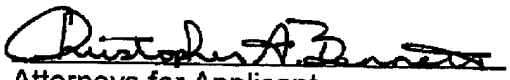
In view of the foregoing Amendments and Remarks, Applicant respectfully submits that this Application is in condition for allowance. Favorable consideration and prompt allowance are respectfully solicited.

To the extent necessary, Applicants petition the Commissioner for a Two-month extension of time, extending to March 2, 2003, the period for response to the Office Action dated October 2, 2002.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: February 27, 2003



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

5. (four times amended) An image processing device comprising:

image processing means for executing image processing to move an object to different positions on a display means;

display means for displaying an image at an object display position based on the image processing;

contact means movably provided and brought into contact with said display means by the operation of a player;

input means [located near] provided on a side of said display means and generating at least one signal for computing a contact position when said contact means is brought into contact with said display means, such that the strength of the at least one signal depends on the contact position;

position computing means for computing said contact position based on the at least one signal from the input means; and

determination means for determining whether a desired positional relationship is established between said contact position and said object display position based on a computed result;

wherein said image processing means provides prescribed image processing of said object when the determination means determines that the desired positional relationship has been established.

16. (four times amended) A method for processing images, comprising:

executing image processing to move an object to different positions on a display;

displaying an image based on the step of executing image processing;

providing contact to a display by the operation of a player, and generating a signal for computing a contact position when the contact has been made with said display such that the strength of the signal depends on the contact position;

computing said contact position based on the signal; and

determining whether a desired positional relationship is established between said contact position and an object display position, wherein said executing step provides prescribed image processing of said object when it has been determined that the desired positional relationship has been established.

17. (four times amended) A method for processing images, comprising:

executing image processing to move an object to different positions on a display;

displaying an image based on the image processing;

receiving a contact input when a player provides contact to a display;

generating a signal to compute a contact position when the contact has been made with said display <u>such that the strength of the signal depends of the contact position</u>;

computing said contact position based on the signal; and

determining whether a desired positional relationship is established between said contact position and an object display position, wherein said executing step provides prescribed image processing of said object when it has been determined that the desired positional relationship has been established.

19. (amended) A computer-readable medium encoded with instructions for directing a processor to:

execute image processing to move an object;

display an image based on the execution of image processing;

generate a signal for computing a contact position when contact occurs within a predetermined distance from the object <u>such that the strength of the signal depends on the contact position</u>;

compute the contact position based on the <u>plurality of</u> signals; and

determine whether a [prescribed] <u>desired positional</u> relationship is established between the contact position and an object display position, wherein the image processing provides prescribed image processing of said object when it has been determined that the [prescribed] <u>desired positional</u> relationship has been established.

20. (amended) A computer-readable medium encoded with instructions for directing a processor to:

execute image processing to move an object;

display an image based on the image processing;

receive a contact input when contact occurs within a predetermined distance from the image;

generating a signal to compute a contact position when receiving the contact input; compute the contact position based on the signal such that the strength of the signal depends on the contact position; and

determine whether a [prescribed] desired positional relationship is established between the contact position and an object display position, wherein the image processing provides prescribed image processing of the object when it has been determined that the [prescribed] desired positional relationship has been established.

21. (amended) An image processing system comprising:

an image processing module for performing image processing for moving an object to different positions on a display module;

a display module for causing the display of an image based on the image processing performed by the image processing module;

a contact input module provided on a side of said display module for receiving a contact input when contact occurs within a predetermined distance from the object and for generating a signal to compute a contact position when receiving the contact input such that the strength of the signal depends on the contact position; and

a determiner module for determining whether a desired positional relationship is established between the contact position and an object display position, wherein the image processing module provides prescribed image processing of the object when it has been determined that the desired positional relationship has been established.

23. (three times amended) An image processing device comprising:

an image processor for executing image processing to move an object to different positions on a display;

a display for displaying an image based on the image processing;

a contact unit movably provided and brought into contact with the display;

an input module provided on a side of the display for generating a position indicating signal when the contact unit is brought into contact with the display at a contact position such that the strength of the position indicating signal depends on the contact position;

a position module for computing the contact position based on the position indicating signal generated by the input module; and

a determiner module for determining whether a desired positional relationship is established between the contact position and an object display position, where said image processor provides prescribed image processing of the object when the desired positional relationship has been established.